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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,391	09/29/2000	Marcia Rojewski	Hartford-3	1818
7590	12/05/2003			
ARTHUR L. PLEVY, ESQ. Duane, Morris & Heckscher LLP Suite 100 100 College Road West Princeton, NJ 08540			EXAMINER FRENEL, VANEL	
			ART UNIT 3626	PAPER NUMBER
DATE MAILED: 12/05/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/676,391  <b>Examiner</b> Vanel Frenel	<b>Applicant(s)</b> ROJEWSKI ET AL.  <b>Art Unit</b> 3626
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 29 September 2000.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |                                                                                                            |                                                                             |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Notice to Applicant

1. This communication is in response to the application filed on/09/29/00. Claims 1-21 are pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful of arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-20, do not show any structure or functionality to suggest that a computer performs the recited steps.

Examiner respectfully suggests a common usage of terms such as "computer readable medium or a "computer system" are well taken to be within the statutory categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implemented on a "computer readable medium or a "computer system" (as appropriate), provided Applicant show proper support for such recitations in the originally filed specification.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aquila et al (2002/0035488) in view of Freedman et al (2002/0002475).

(A) As per claim 1, Aquila discloses a method for identifying select ones of insurance records which possess a favorable subrogation potential (Page 2, Paragraphs 0017-0026) the method comprising: receiving data indicative of a plurality of claims (Page 5, Paragraphs 0094-0096); automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data (Page 11, Paragraphs 0214-0223).

Aquila does not explicitly disclose automatically identifying risk factors for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery.

However, these features are known in the art, as evidenced by Freedman. In particular, Freedman suggests automatically identifying risk factors for each of the select claims; and, automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery (See Freedman, Page 8, Paragraphs 0127-0133).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Freedman within the system of Aquila for providing numerous competitive advantages, including: policyholder premiums which are reduced when compared to policies offered by other profitable insurers; claims are processed in the most expeditious manner possible by high quality auto repair providers (See Freedman, Page 2, Paragraphs 0023-0030).

(B) As per claim 2, Freedman discloses the method further comprising automatically providing recovery strategy recommendation and recovery specialist checklists to optimize steps taken to recover losses at minimum expense (Page 8, Paragraphs 0118-0132).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Freedman discloses the method wherein the receiving the data comprises: receiving the data in electronic form (Page 8, Paragraphs 0118-0132).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Freedman discloses the method wherein the receiving the data comprises: providing a user interface (Page 8, Paragraphs 0118-0127); and, extracting the data from the user interface (Page 8, Paragraphs 0118-0132).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Freedman discloses the method wherein the calculating the base score comprises calculating a likelihood a payment will be made by a legally liable party (Page 11, Paragraphs 0159-0163).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Aquila discloses the method wherein the calculating a base score further comprises calculating a probable percentage of losses recovered through payments received from said legally liable party (Page 10, Paragraphs 0173-0210); Page, 18, Paragraphs 0314-0317).

(G) As per claim 7, Aquila discloses the method wherein the calculating a base score further comprises: identifying at least one economic factor pertinent to said base score (Page 11, Paragraphs 0200-0216); and, calculating a first adjustment dependently upon said identified at least one economic factor (Page 11, Paragraphs 0200-0216; Page 12, Paragraphs 0217-0224).

(H) As per claim 8, Aquila discloses the method wherein the calculating a base score further comprising: identifying at least one collection efficiency or strategy pertinent to said base score (Page 10, Paragraph 0173); and, calculating a second adjustment dependently upon said identified at least one collection efficiency or strategy (Page 12, Paragraphs 0217-0224).

(I) As per claim 9, Freedman discloses the method wherein the calculating a base score further comprising calculating said base score using said calculated likelihood a payment will be made, calculated probable percentage of losses recovered, calculated first adjustment and calculated second adjustment (Page 5, Paragraphs 0067-0085).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Freedman discloses the method wherein said risk factors are identified using additional data from at least one external database (Page 1, Paragraphs 0011-0017; Page 3, Paragraph 0035).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(K) As per claim 11, Freedman discloses the method wherein said risk factors address recovery expectations due to limitations of legal process arising from state prohibitions (Page 3, Paragraphs 0043-0047; Page 7, Paragraphs 0107-0115).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(L) As per claim 12, Freedman discloses the method wherein said risk factors address recovery expectations due to state recovery limitations based on a said legally liable party's culpability (Page 3, Paragraphs 0043-0047; Page 7, Paragraphs 0107-0115).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(M) As per claim 13, Freedman discloses the method wherein said risk factors address if other agencies have attempted and failed to recover on the claim, and said

agencies are selected to include attorneys, in-house efforts or outside agents (Page 1, Paragraphs 0007-0010).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(N) As per claim 14, Freedman discloses the method wherein said risk factors address expected difficulties is locating said legally liable party (Page 1, Paragraphs 0013-0015).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(O) As per claim 15, Aquila discloses the method wherein said risk factors address issues selected from the group consisting of expectations due to limitations of legal process arising from state prohibitions, recovery expectations due to state recovery limitations based on a said legally liable party's culpability, if other agencies have attempted and failed to recover on the claim, and expected difficulties is locating said legally liable party (Page 12, Paragraphs 0228-0237).

(P) As per claim 16, Freedman discloses the method further comprising quantifying said value indicative of an expected subrogation recovery at specific periods of time (Page 9, Paragraphs 0130-0141).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(Q) As per claim 17, Freedman discloses the method wherein said quantified values factor in expected collection expenses (Page 0130-0135).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(R) As per claim 18, Aquila discloses the method wherein said quantifying at specific periods of time comprises: calculating a liquidation value for said claim for each specified period of time (Page 19, Paragraphs 0313-0327); calculating an expected expense value for said claim for each specified period of time (Page 19, Paragraphs 0313-0327); and, specified period of time using said calculated liquidation and expected expense values (Page 19, Paragraphs 0313-0327).

(S) As per claim 19, Aquila discloses the method further comprising discounting said quantified values to provide net liquidation values for each specified time period (Page 19, Paragraphs 0313-0327).

(T) As per claim 20, Freedman discloses the method wherein the calculating said base score comprises: automatically calculating an expected probability a legally liable party will make a payment (Page 1, Paragraphs 0011-0022); automatically calculating

an expected probable percentage of losses recovered through payments received from legally liable parties (Page 1, Paragraphs 0011-0022); and, automatically adjusting resultant scores for differences due to economic conditions or operation strategies or efficiencies (Page 1, Paragraphs 0011-0022).

The motivation for combining the respective teachings of Aquila and Freedman are as discussed above in the rejection of claim 1, and incorporated herein.

(U) Claim 21 differs from claim 1 by reciting a computerized system for identifying select ones of insurance records which possess a favorable subrogation potential.

As per this limitation, it is noted that Aquila discloses the system comprising: at least one computing device for receiving data indicative of a plurality of claims (Page 5, Paragraphs 0094-0096); and, a computer readable medium being accessible to said computing device, said computer readable medium comprising: a sequence of directions for automatically calculating a base score to identify select ones of the claims which demonstrate at least a given probability of expected subrogation recovery dependently upon the received data using said at least one computing device (Page 5, Paragraphs 0094-0096) and Freedman discloses a sequence of directions for automatically identifying risk factors for each of the select claims using said at least one computing device; and, a sequence of directions for automatically scoring each of the select claims dependently upon the base scores and identified risk factors to provide a value indicative of an expected subrogation recovery using said at least one computing device (See Freedman, Page 8, Paragraphs 0127-0133).

Thus, it is readily apparent that these prior art systems utilize a computerized to perform their specified function.

The remainder of claim 21 is rejected for the same reasons given above for claim 1, and incorporated herein.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches legal strategic analysis planning and evaluation control system and method (5,875,431), integrated marketing and operations decisions-making under multi-brand competition (6,009,407) and computerized system and method for work management (5,557,515).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F  
November 28, 2003

Alexander Abramowicz  
Alexander Abramowicz  
Primary Examiner  
M 312